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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,353	03/26/2001	Philip S. Siegel	067439-0111	4525
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BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			EXAMINER SHAAWAT, MUSSA A	
			ART UNIT 3627	PAPER NUMBER
			NOTIFICATION DATE 09/05/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 09/817,353	Applicant(s) SIEGEL, PHILIP S.	
	Examiner MUSSA A. SHAAWAT	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 10-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 35-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/9/08, 5/28/08, 2/1/08, 1/4/08</u> . | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. This action is in response to amendment filed on 10/26/2007. Claims 1, 8, 41 and 46 have been amended. Claims 10-34 have been previously withdrawn. Claims 1-9 and 35-46 are pending examination.
2. IDS submitted on 07/09/2008 have been considered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 1-7, 9, 35-43 and 45-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Williams et al., US PG. Pub. No. (2002/0032612) referred to hereinafter as Williams.

As per claim 1, Williams teaches a method for processing the returns of merchandise purchased through the World Wide Web comprising: receiving from a consumer an electronic request via a computerized system associated with the consumer, the electronic request requesting to initiate processing of one or more items of merchandise purchased by the consumer in a prior purchase transaction (see at least Claim 22, Abstract); in response to receiving the electronic request from the computing system associated with the consumer gathering transaction history data associated with

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the consumer from a computerized database (see at least Claim 22, Abstract); displaying the transaction history associated with the identified consumer to the consumer on the computerized system associated with the consumer, the transaction history identifying a listing of merchandise associated with the consumer (see at least Para 0243-0244); in response to and after displaying the transaction history, receiving an electronic selection, generated by the consumer on the computerized system associated with the consumer, of a particular item of merchandise within the listing of merchandise in the displayed transaction history, the electronic selection comprising a click on the particular item of merchandise within the list of merchandise and identifying the particular item of the merchandise for returns and processing (see at least Para 0243-0244); and in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction, the returns process initiated by a returns server (see at least Para 0243-0244).

As per claim 2, Williams teaches a method of Claim 1 further comprising retrieving a preference profile for the identified consumer (see at least Para 0532, 0426).

As per claim 3, Williams teaches crediting a consumer account indicated in the consumer preference profile based upon the item selected (see at least Para 0532).

As per claim 4, Williams teaches a method of Claim 1 further comprising notifying a retailer associated with the item selected by the consumer (see at least Para 0532).

As per claim 5, Williams teaches a method of Claim 4 further comprising providing the retailer with the transaction information and consumer information associated with the item selected by the consumer (see at least Para 0242).

As per claim 6, Williams teaches a method of Claim 1 further comprising generating a return shipping label for the merchandise to be returned (see at least Para 0023).

As per claim 7, Williams teaches notifying a shipping provider of a merchandise return to be picked up (see at least Para 0359).

As per claim 9, Williams teaches a method of Claim 1 further comprising communicating between a client system and a server system via the Internet (see at least fig. 3a, Para 0138).

As per claim 35, Williams teaches a method of Claim 2, further comprising completing the returns process based upon settings in the consumer preference profile (see at least Para 0293-0294, 0573).

As per claim 36, Williams teaches a method of Claim 2, wherein the consumer preference profile comprises a name associated with the consumer, credit information associated with the consumer, and shipping information associated with the consumer (see at least Para 0573, 496, 471, 484).

As per claim 37, Williams teaches a method of Claim 1, wherein identifying the consumer comprises identifying the consumer using a login process (see at least Para 0174, fig. 6).

As per claim 38, Williams teaches a method of Claim 37, further comprising requesting transaction history data from a retailer on a real-time basis upon identifying the consumer using the login process (see at least Para 0026 and abstract).

As per claim 39, Williams teaches a method of Claim 1, further comprising receiving transaction history data from a retailer on a periodic basis (see at least abstract, 0026).

As per claim 40, Williams teaches a method of Claim 1, wherein the listing of merchandise in the transaction history is indicative of merchandise purchased by the consumer from an e-tailer (see at least abstract, 0026).

As per claim 42, Williams teaches the step of determining whether the return is valid prior to the downloading step (see at least Para 0253).

As per claim 43, Williams teaches comparing information associated with the selection of the item of merchandise to at least one return rule of a retailer associated with the transaction (see at least Para 0252, 0017, 0021).

As per claim 45, Williams teaches a method of Claim 1, wherein initiating the return process comprises using the computerized system associated with the consumer to generate a return shipping label to be used to return the selected item (see at least Para 0023).

As per Claims 41 and 46, the limitations of claims 41 and 46 are similar to the limitations of claim 1; therefore it is rejected based on the same rationale

Claim Rejections - 35 USC § 103

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Roman et al., US PG Pub. No. (US 2002/0010634 a1) .

As per claim 8, Williams teaches the overall invention, he does not expressly teach auctioning the merchandise selected for return by the consumer. However, Roman teaches returns disposition including resale of product returns via auction over the internet (see at least Para [0003]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Roman into the disclosure of Williams in order to minimize the loss of revenues of the merchant.

As per claim 44, Williams does not expressly teach determining if the selected item of merchandise is perishable. However it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Williams to include determining if the selected item or merchandise is perishable, since Williams teaches an interface which presents the consumer with a questionnaire about the item or merchandise to be returned, one would be motivated to include determining if the item to be returned is perishable or not so that appropriate measures or actions could be taken to protect the item when being shipped during increased temperatures around the country between the months of for example June-August, such as choosing an

expedited method of shipment and heat safe packaging to protect the highly perishable products which are sensitive to heat.

Response to Arguments

7. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to form 892 for cited references.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mussa A. Shaawat whose telephone number is 571-272-2945. The examiner can normally be reached on Mon-Fri (8am-5:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mussa A Shaawat/
Examiner, Art Unit 3627
August 24, 2008

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627